

REMARKS

Claims 1-51 were filed in the present case. The claims were subject to a restriction requirement. The Applicants elected Claims 1-43 in a prior response. As such, Claims 1-43 are pending and stand rejected by the Examiner. Applicants note that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future.

The Examiner has objected to Claims 15, 27, and 43 because "a claim to a product can not depend from a method of using a product." (Office Action, pg. 2). The Applicants respectfully disagree with this rejection. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have canceled Claims 15, 27, and 43. As such, the objection is moot.

In the present Office Action, the Examiner made a number of arguments, objections, and rejections. For clarity, the rejections at issue are set forth by number in the order they are herein addressed:

- (1) Claims 28-43 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite;
- (2) Claims 15, 27, and 43 stand rejected under 35 U.S.C. 102, as allegedly being anticipated by U.S. Patent 5,770,373 to Britschgi *et al.* (hereinafter Britschgi); and
- (3) Claims 15, 27, and 43 stand rejected under 35 U.S.C. 102, as allegedly being anticipated by U.S. Patent 5,846,723 to Kim *et al.* (hereinafter Kim).

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

I. The Claims are not Indefinite

The Examiner has rejected Claims 28-43 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite (Office Action, pg. 2). In particular, the Examiner states that it is unclear what is encompassed by the phrase "wherein said length of said amplification products provides a distance of an accessible site on said target nucleic acid from said first domain." (Office Action, pgs. 2-3). The Applicants respectfully disagree with this rejection. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended claim 28. The Applicant submit that the amended claim 28 clearly define the meaning of all of the claim terms. As such, the applicants respectfully request that the rejection be withdrawn.

II. The Claims are not Anticipated

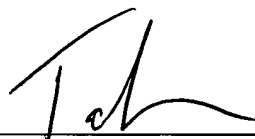
The Examiner has rejected Claims 15, 27, and 43 stand rejected under 35 U.S.C. 102, as allegedly being anticipated by Britschgi or Kim (Office Action, pgs. 3-4). The Applicants respectfully disagree. However, as described above, Claims 15, 27, and 43 have been canceled. As such, the rejection is moot.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' claims should be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: _____

5/21/04



Tanya A. Arenson
Reg. No. 47,391
MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500